



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Venegas, Jr.

Serial No.: 09/815,628

Group No.: 3679

Filed: March 23, 2001

Examiner: R. Flandro

For: HAND RAIL SYSTEM

RESPONSE TO OFFICE ACTION

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Reg. for #6
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Dear Sir:

In response to the Office Action mailed August 1, 2003, the Examiner's attention is directed to the following remarks.

In rejecting claims under 35 U.S.C. § 103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed modification, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, the Examiner states that claims 17, 5, 6, 8 and 25 are obvious over Venegas I ('739) in view of Venegas II ('077) "for the purpose of facilitating removal and installation of said assembly and distinct locations as taught by Venegas II." Applicant respectfully disagrees. There is nothing in the prior art in support of the Examiner's conclusion, and, in fact, Venegas I teaches away from "removal and installation in distinct locations." Reference is made to column 3, lines 3-7 of Venegas I, where it disclosed that the vertical that stanchions which extend beyond the polymerized sheaths "provide means for fixedly securing the guard rail assembly 10 to a support foundation, such as a cement sidewalk 48." This, in conjunction with other references to weather-resistance, and the like,

Serial No.: 09/815,628

- 2 -

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make it clear that Venegas I had no intention of disassembling the guard rail and putting it someplace else. Rather, this is intended for permanent installation, embedded in concrete. Given that there are no teachings or suggestions in support of the combination advanced by the Examiner, *prima facie* obviousness is clearly precluded.

Claim 7 is allowable for the same reasons set forth above. Claims 17 and 15 stand rejected over Venegas I in view of Bobrowski ('457). The Examiner once again concedes that Venegas I does not disclose rails that are releasably engaged, but argues that since Bobrowski allegedly has this feature, it would have been obvious to include releasable engagement "for the purpose of facilitating adjustability and flexibility of said assembly as taught by Bobrowski." Applicant respectfully disagrees. The assembly is Venegas I is clearly intended to be a permanent installation, such that the disclosure of Venegas I teaches away from "adjustability and flexibility." Obviousness is not available in this case.

Based upon the foregoing, Applicant believes all claims are in condition for allowance. To expedite prosecution, the Examiner is invited to contact the undersigned by telephone or facsimile.

Respectfully submitted,

By: _____

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